

### REMARKS

The above amendments and following remarks are submitted in response to the first official action of the Examiner (i.e., Paper No. 2) mailed July 30, 2003. This amendment is deemed to fully respond to all objections and rejections of the Examiner. Thus, claims 1-20, being all pending claims, are now submitted to be in condition for allowance. Entry of this amendment and reconsideration to that end are respectfully requested.

Though the Examiner has not objected to the specification, there was certain material needed to complete the Cross Reference to Co-Pending Applications. In response thereto, page 1 of the specification has been amended.

The Examiner has made objections to certain informalities with regard to claims 1, 7, and 12. In response thereto, these claims have been amended above.

The Examiner has rejected claims 4, 5, 9, 10, 14, 15, and 20 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. This ground of rejection is respectfully traversed as inconsistent with controlling law.

Specifically, the Examiner states:

The version of each of these software packages (WebTX, ASP, VB, Windows, Windows NT) or the type of computer

is critical or essential to the practice of the invention, but not included in the claim(s) (sic) is not enabled by the disclosure.

Though it is not clear whether the Examiner's concern is that the "version" or "type" is not presented in the claims, not presented in the specification, or not presented in either, the rejection is deemed improper for three basic reasons.

First, the Examiner has not presented any authority to support his finding that the "version" and/or "type" is "critical or essential to the practice of the invention". Therefore, it is assumed that the Examiner has merely assumed that this is true without attempting to verify the assumption. He has not even established that each of these has a "version" and/or "type". Therefore, this underlying fact finding is deemed clearly erroneous.

Second, with regard to the preferred embodiment, the specification at page 24, lines 4-5, states:

The Unisys ClearPath IX Server 310 includes both an OS 2200 environment 312 and a Windows NT environment 314.

Were the reader to purchase the Unisys ClearPath IX Server from Unisys Corporation, he/she would obtain whatever "versions" or "types" required to practice the preferred mode of the present invention. Therefore, the fact finding is clearly erroneous with regard to the preferred mode.

Third, the rejection of the Examiner fails to comport with controlling law. MPEP 2164.08(b) provides:

The presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984) (prophetic examples do not make the disclosure nonenabling).

Even if the Examiner's findings of fact were not clearly erroneous, he has not made the findings required by MPEP 2164.08(b). Therefore, the rejection is respectfully traversed as both incorrect as a matter of law and based upon clearly erroneous findings of fact.

For some reason, the Examiner also rejects claims 4, 5, 9, 10, 14, 15, and 20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This ground of rejection is respectfully traversed for the following reasons.

Each of the rejected claims depends from one or more broader, but not rejected, claims. It is not understood how these non-rejected, broader claims can "particularly point out and distinctly claim" subject matter which becomes indefinite

when narrowed by the rejected claims. Perhaps, the Examiner confuses indefiniteness with breadth. MPEP 2167 provides:

**2173.04 Breadth Is Not Indefiniteness**

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention as evidenced by statements outside of the application as filed, a rejection under 35 U.S.C. 112, second paragraph would be appropriate. If the claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection under 35 U.S.C. 112, first paragraph would be appropriate. If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.

To the extent understood, the rejection is respectfully traversed as improper and inconsistent with controlling law.

The Examiner has rejected claim 1-3, 6-8, and 11-19 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,370,588 B2, issued to Gebauer (hereinafter referred to as "Gebauer"). This ground of rejection is respectfully traversed for the following reasons.

The standard for a finding of anticipation is provided in MPEP 2131, which provides in part:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The rejection is respectfully traversed because Gebauer does not "either expressly or inherently describe" "each and every element" of the claimed invention.

Specifically, claim 1 is limited "wherein said transaction request has one of a plurality of formats". The user terminal of Gebauer, on the other hand, can only make service requests in a single format (i.e., HTML). Column 3, lines 55-56, states:

....transaction data transferred from the user over the internet in HTML format....

As a result, Gebauer does not have the "generic gateway" of the claimed improvement, because Gebauer receives only service requests in a single format (i.e., HTML). Gebauer has a "gateway" which operates with only a single format (i.e., HTML). This is in direct contrast to page 8, lines 15-19, which states:

A plurality of adapters convert each of the differing request formats into a single input format for the single generic gateway. In this manner, a client may make a service request via C++, ASP (i.e., an active server page from a web browser), or other format.

Therefore, the rejection of claim 1, and any claim depending therefrom, is respectfully traversed because Gebauer does not permit users to utilize a plurality of formats for transaction requests because it does not have the claimed "generic gateway".

Claim 2 depends from claim 1 and is further limited to a plurality of adapters between the user terminal and the "generic gateway" wherein there is a different adapter for each of the permitted formats. In making his rejection, the Examiner confusingly states:

"...where the clients (sic) request is adapted to use each service 70 and 72.

This misquotes the reference, misstates the clear operation thereof, and is legally irrelevant, because it does not address the claim limitation. The rejection of claim 2 is respectfully traversed.

In rejecting claims 6-8, the Examiner states:

Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

This statement is clearly erroneous factually, because claims 6-8 are limited by an additional "server" containing the "generic gateway" which is not limiting of claims 1-3. Therefore, in addition to the arguments made above with regard to the rejection of claims 1-3, the rejection of claims 6-8 is also respectfully traversed as based upon this clearly erroneous finding of fact.

In rejecting claims 11 and 16, the Examiner states:

Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same

reasons set forth in the rejection of claims 1 and 2 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 11 and 16 are different as a matter of law. Claims 1 and 2 are apparatus claims. Claim 11 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore, claim 16 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 16 is to be performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 11 and 16 are respectfully traversed as a matter of law in addition to the arguments made above.

In rejecting claims 12 and 17, the Examiner states:

In both cases, once the request has been adapted (converted, processed) it is directed to the actual service provider via the connection between them).

Thus, instead of addressing Applicants' claim limitations, the Examiner has attempted to redefine them to better comport with his reading of Gebauer. This is procedurally incorrect as a matter of law. The Examiner is reminded that Applicant may be his own "lexicographer" as a matter of law. The Examiner is required to utilize Applicants' definitions. He is not free to choose his own. Page 26, lines 5-8, of the specification should be sufficient to provide the Examiner with a working definition

of the claim limitation, "connector". The rejection of claims 12 and 17 are respectfully traversed as contrary to controlling law and as based upon clearly erroneous findings of fact.

In rejecting claims 13 and 19, the Examiner states:

Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 13 and 19 are different as a matter of law. Claim 3 is an apparatus. Claim 13 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore, claim 19 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 19 is to be performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 13 and 19 are respectfully traversed as a matter of law in addition to the arguments made above.

In rejecting claim 14, the Examiner states:

Referring to claim 14, Gebauer has taught the method wherein said one of said plurality of formats further comprises an active server page (Gebauer figure 4, elements 70 and 72).

The Examiner has confused the format of the "service request" of claim 14, which has the format of an Active Server Page (ASP),



with the service of Gebauer which may be scripted as an ASP. In the claim, a service request, formatted as an ASP, is transferred to the server via the publically accessible digital data communication network. In Gebauer, as service request, formatted as an HTML page, is transferred to the server via the Internet, which may activate ASP scripting. The user terminal of Gebauer can only make service requests in HTML. The rejection of claim 14 is respectfully traversed as based upon clearly erroneous findings of fact.

The Examiner makes the same mistake with his rejection of claim 15. In fact, the citation of the Examiner specifically contradicts the Examiner's position. It states at column 8, lines 24-25:

On the other hand, open services may have server-side scripting in a variety of common commercial languages..... (emphasis added)

As with the ASP script, the Visual Basic script exists only on the "server-side". It is not transferred from the user terminal. The rejection of claim 15 is respectfully traversed as based upon clearly erroneous findings of fact.

As with his rejection of claims 12 and 17, the Examiner impermissibly "bends" the terminology of claim 18 to comport with his rejection. The rejection of claim 18 is respectfully traversed as inconsistent with controlling law.

Claims 1-3, 6-8, 11-13, and 16-19 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,845,267, issued to Ronen (hereinafter referred to as "Ronen"). This ground of rejection is respectfully traversed for the following reasons.

In rejecting claim 1, the Examiner has again impermissibly redefined Applicants' claim limitations to suit his theory of rejection. He states:

....transaction server 121 acts as a gateway between user terminal 101 and server 126.

The Examiner's attention is directed to the specification at page 8, lines 9-12, and page 6, lines 2-4, for Applicants' definition of a "generic gateway". As a matter of law, the Examiner must utilize this definition for his examination. A "generic gateway" is not a "server". The rejection of claim 1 is respectfully traversed as inconsistent with controlling law.

In his rejection of claim 2, the Examiner repeats his legal error by stating:

....where the adapters are settings processed by the transaction server and passed on to the billing server to determine which services are rendered and how they are rendered.

Not only is this statement completely inconsistent with controlling law, it does not even make any sense. The Examiner is simply not permitted to redefine Applicants' claim limitations

to meet his rejection theories. The rejection of claim 2 is respectfully traversed.

In rejecting claims 6-8, the Examiner states:

Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

This statement is clearly erroneous factually, because claims 6-8 are limited by an additional "server" containing the "generic gateway" which is not limiting of claims 1-3. Therefore, in addition to the arguments made above with regard to the rejection of claims 1-3, the rejection of claims 6-8 is also respectfully traversed as based upon this clearly erroneous finding of fact.

In rejecting claims 11 and 16, the Examiner states:

Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the rejection of claims 1 and 2 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 11 and 16 are different as a matter of law. Claims 1 and 2 are apparatus claims. Claim 11 is a method claim primarily limited by process steps rather than apparatus structure.

Furthermore, claim 16 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 16 is to be

performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 11 and 16 are respectfully traversed as a matter of law in addition to the arguments made above.

In rejecting claims 12 and 17, the Examiner states:

....transferring said converted and processed service request from said generic gateway to an end service provider via a connector (Ronen figure 1 and column 5, line 43 - column 6, line 9 where the request is passed to the billing server (column 6, lines 10-13).

Thus, instead of addressing Applicants' claim limitations, the Examiner has attempted to redefine them to better comport with his reading of Ronen. This is procedurally incorrect as a matter of law. The Examiner is reminded that Applicant may be his own "lexicographer" as a matter of law. The Examiner is required to utilize Applicants' definitions. He is not free to choose his own. Page 26, lines 5-8, of the specification should be sufficient to provide the Examiner with a working definition of the claim limitation, "connector". The rejection of claims 12 and 17 are respectfully traversed as contrary to controlling law and as based upon clearly erroneous findings of fact.

As with his rejection of claims 12 and 17, the Examiner impermissibly "bends" the terminology of claim 18 to comport with his rejection. The rejection of claim 18 is respectfully traversed as inconsistent with controlling law.

In rejecting claims 13 and 19, the Examiner states:

Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

This statement is clearly erroneous factually as can be readily appreciated by simply reading the claims. In addition, the scope of claims 13 and 19 are different as a matter of law. Claim 3 is an apparatus. Claim 13 is a method claim primarily limited by process steps rather than apparatus structure. Furthermore, claim 19 is an apparatus claim having "means-plus-function" limitations, providing a different statutory basis for patentability. For that reason, examination of claim 19 is to be performed in accordance with MPEP 2181, et seq. Therefore, the rejection of claims 13 and 19 are respectfully traversed as a matter of law in addition to the arguments made above.

Claims 1-13 and 16-20 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,397,220 B1, issued to Deisinger et al (hereinafter referred to as "Deisinger"). This ground of rejection is respectfully traversed for the reasons provided below.

Apparently in an attempt to avoid actually considering the teachings of Deisinger, the Examiner summarily rejects claim a on Deisinger Fig. 1. Though Applicants' Fig. 1 and Fig. 1 of Deisinger are similar, this just establishes that the preferred environment for each is similar. If the Examiner would kindly

compare Fig. 3 of Deisinger with Fig. 4 of the present application, he would note that Deisinger has a plurality of different gateways (i.e., 236, 240, 244, 248, 252, 256, 260, and 264) to accommodate service requests of differing formats. Applicants', on the other hand, accommodate these differing formats through the use of a single generic gateway (i.e., GGATE 72). Therefore, the rejection of claim 1 is respectfully traversed as based upon clearly erroneous findings of fact.

The rejection of claim 2 is similarly based upon a clearly erroneous finding of fact. The Examiner clearly erroneously states:

(Deisinger figure 2, element 229 where the user's request is adapted based on the type of service).

Not only is this statement clearly erroneous, it is completely unsupported by the reference. Furthermore, even if true, this would not meet the limitations of claim 2 which requires "a plurality of adapters interposed between said generic gateway and said user terminal". Element 229 of Fig. 2 is not so located. The rejection of claim 2 is respectfully traversed as based upon clearly erroneous findings of fact.

In his rejection of claims 5, 10, and 20, the Examiner states:

Deisinger column 4, lines 40-46 where Windows is the standard operating system for a computer conventionally termed a "PC").

This statement is ambiguous. It is clear that the citation references a plurality of "PC/workstations". Nothing is said of the operating system. Therefore, the operating system limitation is not expressly disclosed by Deisinger. The only other finding which would support the Examiner's rejection is inherency of Windows as the operating system. However, the Examiner has clearly not met his burden under MPEP 2112 for showing inherency. Furthermore, because other operating systems could be utilized (e.g., Unix), it seems unlikely that the Examiner could not meet his burden. Therefore, the rejection of claims 5, 10, and 20 is respectfully traversed as at least incomplete and probably based upon clearly erroneous findings of fact.

In rejecting claims 6-8, the Examiner states:

Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

This statement is clearly erroneous factually, because claims 6-8 are limited by an additional "server" containing the "generic gateway" which is not limiting of claims 1-3. Therefore, in addition to the arguments made above with regard to the rejection of claims 1-3, the rejection of claims 6-8 is also respectfully traversed as based upon this clearly erroneous finding of fact.

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In rejecting claims 12 and 17, the Examiner states:

....transferring said converted and processed service request from said generic gateway to an end service provider via a connector (Deisinger figure 2 and column 5, lines 27-51 where the middleware adapats/converts/processes the requests and routes the it (sic) to the correct server provider via connections 225, 227, etc.).

Thus, instead of addressing Applicants' claim limitations, the Examiner has attempted to redefine them to better comport with his reading of Deisinger. This is procedurally incorrect as a matter of law. The Examiner is reminded that Applicant may be



his own "lexicographer" as a matter of law. The Examiner is required to utilize Applicants' definitions. He is not free to choose his own. Page 26, lines 5-8, of the specification should be sufficient to provide the Examiner with a working definition of the claim limitation, "connector". The rejection of claims 12 and 17 are respectfully traversed as contrary to controlling law and as based upon clearly erroneous findings of fact

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As with his rejection of claims 12 and 17, the Examiner impermissibly "bends" the terminology of claim 18 to comport with

his rejection. The rejection of claim 18 is respectfully traversed as inconsistent with controlling law.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, being the only pending claims.

Respectfully submitted,

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By their attorney,

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